

~~eff 18~~
10-10-01
Dow

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of:)
Munehiro DATE et al.) Atty. Docket No.: **ASAIN0058**
Serial No. 09/434,498)
Filed: November 5, 1999)
For: REVERSIBLE HEAT-SENSITIVE) Group Art Unit: 1774
PAPER AND METHODS FOR)
WRITING INFORMATION) Examiner: B. HESS
Date: October 1, 2001

RECEIVED
OCT 09 2001
TC 1700

**PETITION TO WITHDRAW
RESTRICTION/ELECTION REQUIREMENT**

BOX: FEE - PETITIONS

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a petition to withdraw the Examiner's restriction/election requirement dated August 29, 2001 in the above-captioned application (copy attached as Exhibit A). Applicant believes that the Examiner's restriction/election requirement does not comply with the requirements for a proper restriction as stated in the USPTO guidelines set out in the Manual of Patent Examining Procedure.

There are several criteria for a proper requirement for restriction between independent or patentably distinct inventions: (A) the inventions must be independent or distinct as claimed; and (B) there must be a serious burden on the examiner if restriction is required. MPEP §803, (7th Edition, July 1997). "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." *Id.* (Emphasis added.)

In the present case, the Examiner has already examined all claims on the merits, thus admitting that the examination of all claims imposes no serious burden on the Examiner. An Action in which claims 1-5 were all examined on the merits was issued on March 20, 2001 (copy attached as Exhibit B). In a response to the March 20, 2001 Action dated June 20, 2001, applicants incorporated the limitations of original claim 2 into claim 1 (copy attached as Exhibit C). Additionally, with that response, new claim 6 was added to claim the method disclosed in the present specification at page 16, lines 18-23, and new claim 7 was added to claim the paper disclosed on page 6, lines 16-20 of the present specification. No new issues were raised by the Amendment.

Moreover, in the restriction requirement itself, the Examiner admits that both sets of claims are classified in Class 503. Clearly no burden is involved where all claims are classified in the same class. Thus, the second requirement of the MPEP for a proper restriction requirement has not been met. There is simply no burden placed on the USPTO to examine claims already examined. According to the USPTO's own procedures, all claims must be examined together in a case such as the present one where there is no serious burden imposed.

The imposition of a restriction requirement, on the other hand, would be wasteful of both the USPTO's and the applicants' resources, and unfairly burden the applicants. The requirement would require the USPTO to examine once again claims already examined, and would require the applicants to file another application for claims that should be examined together.

For the reason above, applicants respectfully request the Commissioner to withdraw the restriction/election requirement dated August 29, 2001.

Attached hereto is the check of the undersigned in the amount of \$130.00 for the fee regarding this Petition. The Commissioner is hereby authorized and requested to charge any additional fees or fee deficiency regarding this Petition, or credit any overpayment, to the

undersigned's Deposit Account No. 50-1281 under an order number corresponding to the
Attorney Docket Number.

Respectfully submitted,

GRiffin & Szipl, PC



Joerg-Uwe Szipl
Reg. No. 31,799

GRiffin & Szipl, PC
Suite PH-1
2300 Ninth Street, South
Arlington, VA 22204

Telephone: (703) 979-5700
Facsimile: (703) 979-7429
Customer No.: 24203